

Appl. No.: 10/632,980
Amdt. Dated: 30 August 2007
Reply to Office Action dated 03/30/2007

Remarks/Arguments

In the Office Action mailed 03/30/2007 the Examiner has rejected claims 1-6 and 8-20 under the judicial doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,892,863 to Everett in view of Smith '747 or Huang '308, and under 35 U.S.C 103(a) as unpatentable over Irvine '973 in view of Everett '959 and Smith '747 or Penny '891 or Huang '308

Double Patenting Rejection

Enclosed is a Terminal Disclaimer under 37CFR 3.73(b) which is submitted to overcome the rejection based on U.S. Patent No. 6,892,863 to Everett. Inasmuch as neither Smith '747 or Huang '308, individually or collectively, teach nor suggest applicants' claimed invention, the rejection under the judicial doctrine of obviousness-type double patenting is submitted as now overcome.

Rejection of claims 1-6 and 8-20 under 35 U.S.C 103(a)

In rejecting claim 1 and citing Irvine '973, the Examiner states that Irvine shows in Fig. 3 a brake pad similar to applicants' and calls attention to brake pad means 28 and pad 12. In reviewing Irvine it is seen that brake pad mount, or shoe, 28 is of an elongated configuration having a slotted channel 30 configured to receive a single brake pad 12.

The Examiner admits that Irvine lacks a showing of multiple brake pads having different braking characteristics, but in attempt to assert Irvine states that it is notoriously well known to make singular parts plural as a matter of obvious engineering design choice. The Examiner is thus apparently suggesting that it would be obvious to separate pad 12 into separate parts.

However, if this separation is effected there would result brake pad 12 divided into a plurality of parts each having the same braking characteristic. Obviously, there would be no incentive to make this design choice since it would not provide any advantages to do so. It would be more expensive to produce and have less reliability, being more subject to pull out of the parts during braking since, as the Examiner also admits, Irvine lacks a showing of closure means in the form of an end cap for complementary mating with the truncated end to secure the brake pads within the brake pad means. Thus, Irvine does not teach adequate pad retention means for a plurality of pads. Further, there is no teaching or suggestion in Irvine of any desirability of dividing of brake means 12.

Thus, even if it is notoriously well known to make singular parts plural as a matter of obvious engineering design choice there is no reason to make this design choice in Irvine. Further, even if so made the combination would not result in applicants' invention as recited in applicants' claim 1.

The Examiner then relies on Everett '959 to assert it is known to create brake pads having different compounds for desired breaking characteristics and refers to Fig. 5 and the Abstract thereof. Fig. 5 illustrates a single main body brake pad having a portion of different braking characteristics embedded therein. It specifically does not teach multiple brake pads. It is clear then that adding the concept of Everett to the plurality of pads resulting from divided pad 12 of Irvine would merely result in a plurality of identical main body pads each having a portion of different braking characteristics embedded therein.

It is to be noted that there is no teaching or suggestion in Irvine, Everett '959, or the combination thereof, of the desirability of dividing brake means 12 and embedding them with portions having different braking characteristics. Further, any combination of Irvine and Everett would be subject to pull out of the parts during braking since neither reference teaches end cap brake pad retention means as claimed by applicants. It is thus clear that applicants' Claim 1 is patentable over Irvine in view of Everett.

It is worthy of note that even though Irvine was filed almost four years after Everett it was apparently not obvious for Irvine to separate his single pad into several pads and then incorporate the teachings of Everett. It was not until over four years after the Irvine filing that with the filing of applicants, and the teachings therein, that any such connection was made. Considering the highly competitive nature of the brake pad business such a connection would have been made much sooner if it had been obvious. Further, applicants' claimed invention has been copied in carefully selected ways throughout the industry since being placed on the market. Consequently the above rejections of the Examiner are respectfully traversed and it is strongly suggested that the Examiner is overly engrossed in dealing with hindsight in his assertion of obviousness.

The Examiner states that Smith is relied on to show it is known in the art to make a brake pad or shoe from multiple parts and refers to elements 2. Elements 2 are seen to be a plurality of wooden filler blocks for bearing against the surface of an automobile wheel. The invention states as its objective to provide an improved construction of a shell (brake shoe) adapted to receive and support blocks of wood (elements 2) to bear against the circumference of the wheel. There is no mention of any advantages of a plurality of elements 2, however, it can be understood that a plurality of elements would be beneficial in enabling conformance to the curvature at the circumference of the wheel. There is no teaching of the desirability of the elements having different braking characteristics. Certainly there is no teaching of the addition of anything to the elements 2 to provide different braking characteristics. Thus, the multiple elements 2 do not add anything over the above combination of Irvine and Everett.

In the attempt to negate the absence in Irvine of a showing of closure means in the form of an end cap for complementary mating with the truncated end to secure the brake pads within the brake pad means, the Examiner has called attention, without comment, to the closure means of Smith at 9 and 10. It is seen that 9 is merely a bar bent at one end to be secured in a slot in a first side 4 of the brake shoe and extending across the brake shoe to extend through a slot in the second side thereof and then secured in position by a pin 10. This bar 9 is obviously not the claimed end cap of applicants' invention and the addition of the bar to the combination of Irvine and Everett would definitely not result in applicants' claim of invention.

Penny is relied upon to show a teaching similar to Smith, the Examiner calling attention, without comment, of closure means in the area of c and f, the letter c depicting the recess holding

the wooden blocks B and f the bolt passing transversally of the brake shoe to retain the blocks B in the recess c. Here again, there is no teaching of the addition of anything to the wooden blocks to provide different braking characteristics and bolt f is certainly not indicative of applicants' claimed end cap.

The Examiner goes on to state that Huang shows in Fig. 2 a similar device to that of Irvine and notes that the pad holds has an integrally formed closed end and shows yet another known alternative for securing the pads.

It is clear that Smith, Penny and Huang only indicate that some sort of end barrier could be conceived. Applicants understand that there may be many alternative methods for securing pads in a brake shoe but suggests that this without more falls woefully short of making applicants' method obvious. With that in mind it is seen that neither the methods of Smith, Penny, Huang, or the combination thereof have any bearing on, and certainly do not teach or suggest, applicants' claimed end cap.

Thus the addition of the teachings Smith, Penny or Huang to the combination of Irvine and Everett would result at best in a plurality of identical main body pads having portions embedded therein of different braking characteristics, and with a simple primitive method of longitudinal compression/restraint of the pads in the holder. Consequently, this combination would not satisfactory work at all, much less like applicants' invention, without additional unobvious substantial reconstruction of the combination. It is known (In re Ratti 123 USPQ 349) that combining references is improper if it would require substantial reconstruction of elements as well as a change in basic principals under which the construction in the anticipatory patent was designed to operate.

It is clear that a combination of references as indicated by the Examiner would still require engineering ingenuity and structural revision to perform the function of the invention of applicants. Further, references are not combined where there is no teaching or suggestion therein that they should or could be combined, absent applicant's disclosure. In the case of Ex part Lennox, 114 USPQ 224, in reversing a rejection based on obviousness, the Patent Office Board of Appeals stated:

We have studied the references and the manner in which the Examiner Proposes to combine their teachings but we are unable to find in these References any suggestion that they should or could be combined, absent Applicant's application. On the contrary we find that the proposed Combination would be bringing together portions of diverse patents dealing with different articles to obtain a product obviously not contemplated by the apparatus disclosed.

It is submitted that this case is precisely on point in light of the Examiner's rejection of applicants' Claim 1 under 35 USC 103, and in view of the above it is submitted that the present Claim 1 clearly avoids such rejection..

Claims 2-6 are dependent directly or indirectly from Claim 1 and further recite limitations not taught or suggested by the references or the combination thereof. Claim 8 is directly dependent from Claim 1 and further recites limitations not taught or suggested by the references or the combination thereof. It is thus submitted that amended Claim 2-6 and claim 8 are free of the '103 rejection.

In view of the above, amended independent Claims 9 and 15 are likewise submitted as free of the '103 rejection as the claimed invention is not taught or suggested by the references or the combination thereof. Additionally, inasmuch as Claims 10-14 are dependent directly or indirectly from Claim 9, it is submitted that these claims are also free of the rejection. Likewise, as present Claims 16-18 are dependent directly or indirectly from Claim 15, it is submitted that these claims are free of the rejection.

Independent method Claim 19 and Claim 20 dependent therefrom are rejected with the comment that it would be obvious to insert the multiple pads sequentially. In view of the above Claim 19 and 20 are thus also submitted as free of the '103 rejection.

Applicants again submit that the Examiner is grossly ignoring the holding in *Hodosh v. Block Drug Co., Inc.* (Fed. Cir. 1986) 229 USPQ 182 wherein it was held that:

1) the claimed invention must be considered as a whole... (though the difference between claimed invention and prior art may seem slight, it may also have been the key to advancement of the art);

(2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination .. ;

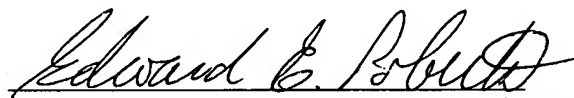
(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention .. ;

Accordingly, and in view of the above, it is suggested that the Examiner consider applicants' claimed invention as a whole and not merely seize upon similarities in selected references that do not suggest the desirability and thus the obviousness of making the combination, to improperly reject applicants' claims. Likewise, it is suggested that the Examiner not view the references with the benefit of hindsight afforded by the present invention since no other cited reference teaches or suggests applicants' now claimed invention. Further, it is submitted that any conclusions reached by the Examiner in relating the references to show the applicants' now claimed invention to be obvious would be an erroneous piecemeal application of the references.

The claims remaining in the case, that is, claims 1-6 and 8-20, have been amended, directly or indirectly, in accordance with the above discussion. Claim 7 has been canceled. It is respectfully requested that the Examiner's rejections be reconsidered, the remaining claims allowed, and the case passed to issue. It is hereby certified that this response to the outstanding Office Action is being deposited with the United States Postal Service, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 30 August 2007.

Dated 30 August 2007

Respectively submitted,



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